

**REMARKS**

The Applicants' attorney has reviewed the Examiner's comments in the Office Action and appreciates the Examiner's care in examining the Application. Also appreciated is the Examiner's indication that claims 1-6 and 10-20 are allowed.

In the Office Action, the Examiner first indicated that the Information Disclosure Statement filed 8/13/02 failed to comply with 37 CFR 1.98(a)(2) insofar as copies of the cited references were not provided and also insofar the relevance of certain foreign-language references was not explained. Also, the Examiner rejected claims 7 and 9 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention, and the Examiner objected to claim 8 due to its dependence upon claim 7.

The Applicants address each of these issues below.

**Resubmission of Information Disclosure Statement Documents**

In a telephone conference with the Patent Examiner on December 18, 2002, the Applicants' attorney explained to the Patent Examiner that copies of the cited references had indeed been submitted to the Patent Office with the original Information Disclosure Statement, and further that an English-language abstract had been included with the sole foreign-language document submitted with the original I.D.S.

The Examiner accepted the Applicants' position that the

missing information for the Information Disclosure Statement had been properly submitted to the Patent Office and apparently misplaced by the Patent Office. The Examiner further indicated that he would fully consider the references of the Information Disclosure Statement upon receiving such information. The Applicants, in response, resubmitted the Information Disclosure Statement and copies of all of the cited references on December 20, 2002 (including the English-language abstract for the one foreign-language reference), which the Examiner acknowledged receiving in a further conference with the Applicants' attorney on February 4, 2003.

**Rejections of Claims 7 and 9 and Objection to Claim 8**

The Examiner, in rejecting claims 7 and 9, indicated that claim 7 lacked a recitation of a relationship between the "rotating counterweight" and other claimed elements, and that claim 9 lacked an antecedent basis for "the engine". Claim 8 was objected to because of its dependence upon claim 7.

In response to the Examiner's rejections and objection concerning the claims, the Applicants have made two amendments to the claims. First, the Applicants have amended claim 7 to particularly recite that "the rotating counterweight is at least one of coupled to a portion of the crankshaft and integrally formed as a portion of the crankshaft". This amendment is supported by the Specification at, for example, paragraph 0036, and does not add new matter. Because amended

claim 7 specifies a relationship between the rotating counterweight and other claim elements, the Applicants respectfully submit that the rejection of claim 7 and the objection to claim 8 are now overcome.

Additionally, the Applicants have amended claim 9 to recite "an engine" rather than "the engine" to rectify the antecedent basis problem, and consequently the Applicants submit that the rejection of claim 9 has been overcome.

\* \* \*

Conclusion

In view of the Applicants' amendments and Remarks being submitted herewith, the Applicants respectfully request reconsideration and allowance of the present Application.

The Applicants wish to invite the Examiner to telephone the Applicants' attorney at the number listed below if discussion with the Applicants' attorney would be of assistance to the Examiner or further the prosecution of the present Application.

Dated: April 14, 2003

Respectfully submitted,  
Terrence M. Rotter et al.

By: John T. Pienkos

John T. Pienkos  
Reg. No. 42,997  
QUARLES & BRADY  
411 East Wisconsin Avenue  
Milwaukee WI 53202-4497  
(414) 277-5777

VERSION SHOWING CHANGES TO CLAIMS

7. (Amended) The balance system of claim 5, further comprising a rotating counterweight, wherein the rotating counterweight is at least one of coupled to a portion of the crankshaft and integrally formed as a portion of the crankshaft.

5 9. (Amended) The balance system of claim 1, wherein the pin is substantially parallel to a central axis of the crankshaft, and wherein the groove is at least one of substantially parallel to a piston axis along which a piston reciprocates within [the] an engine, substantially perpendicular to the central axis, within a plane perpendicular to the central axis, and within another plane formed by the central axis and the piston axis.